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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

066042-9276-04

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on October 18, 2006Signature Kelly F. RobertsTyped or printed name Kelly F. Roberts

Application Number

10/796,365

Filed

3/9/2005

First Named Inventor

Roger Dean Neitzell et al.

Art Unit

3724

Examiner

Hwei Siu Chou Payer

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)☒

attorney or agent of record.

Registration number 51,232☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

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10/18/06

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐

*Total of _____ forms are submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Group Art Unit 3724

In re

Patent Application of

Roger Dean Neitzell et al.

Application No. 10/796,365

Confirmation No. 2254

Filed: March 9, 2004

Examiner: Hwei Siu Chou Payer

“HANDLE ARRANGEMENT FOR A
RECIPROCATING SAW”

I, Kelly Roberts, hereby certify that this correspondence is being deposited with the US Postal Service as first class mail in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date of my signature.

Kelly F. Roberts
Signature
10/18/2006
Date of Signature

REMARKS SUBMITTED WITH REQUEST FOR PRE-APPEAL REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants respectfully traverse the rejections set forth with respect to Claims 1-26 in the Office action mailed August 28, 2006.

Applicants respectfully submit that the Examiner has erred in suggesting that Claims 1-8, 10, 12-19, 21, and 23-26 are unpatentable over U.S. Patent No. 6,102,134 (“Alsrue”), Claims 9 and 20 are unpatentable over Alsrue in view of U.S. Patent No. 4,976,173 (“Yang”), and Claims 11 and 22 are unpatentable over U.S. Patent No. 6,021,573 (“Kikuchi”) in view of Alsrue. Applicants further submit that the rejections set forth in the Office action of August 28, 2006 include clear errors.

A. Independent Claim 1 and dependent Claims 2-11

Alsrue does not teach or suggest a power tool including, among other things, a hand grip being supported for movement relative to the body between a first position, in which the first grip surface and the second grip surface are generally aligned, a second position, in which the second grip surface defines an obtuse angle with respect to the body axis, and a third position, in which the second grip surface is generally perpendicular to the first grip surface, as recited in Claim 1. Rather, as noted by the Examiner, the second housing member 14 of Alsrue is connected to a rear portion 40 of the

first housing member 12 for pivoting movement relative to the first housing member 12 between a first position (shown in Fig. 1), in which the first and second housing members 12, 14 are generally aligned, and a second position (shown in Fig. 2), in which the second housing member 14 is oriented at a non-perpendicular angle with respect to the first housing member 12. For these and other reasons, Alsrue does not teach or suggest the subject matter of Claim 1.

Alsrue mentions that the rear portion 40 of the second housing member 14 can include more detents (in addition to first and second detents 46, 48) “to lock the housing members in additional positions with respect to one another.” Column 3, lines 64-65. The Examiner argues that in view of this reference, “[i]t is inherent or would be obvious that additional positions such as a ‘generally perpendicular’ [position] is or can be included”. Applicants respectfully disagree.

Specifically, Alsrue fails to disclose where such additional detents would be located. In addition, Alsrue fails to disclose how the inclusion of such additional detents would facilitate movement of the second housing member 14 of the power tool 10 of Alsrue toward an orientation, in which a grip surface of the second housing member is generally perpendicular to a grip surface of the first housing member 12. Moreover, Alsrue teaches away from modifying the power tool 10 of Alsrue as suggested by the Examiner.

If the power tool 10 of Alsrue were modified to include additional detents positioned along the rear portion 40 between the first and second detents 46, 48, the second housing member 14 of such a modified power tool 10 would not be able to pivot toward an orientation in which the second housing member 14 is substantially perpendicular to the first housing member 12. Rather, such a modification to the power tool 10 of Alsrue would only enable the second housing member 14 to be pivoted toward positions in which the second housing member 14 is at an obtuse angle (i.e., a non-perpendicular angle) with respect to the first housing member 12.

Alternatively, if the power tool 10 of Alsrue were modified to include an additional detent positioned forwardly from the first detent 46 (i.e., between the first detent 46 and a rearward end of the first housing member 12), the engagement between the rearward end of the first housing member 12 and the forward end of the second housing member 14 (see the upper portion of Fig. 4) would prevent the second housing member 14 from being pivoted about the pivot 44 toward a pivoted position which would allow the pin 90 to engage such an additional detent.

Moreover, even if it was possible to modify the power tool 10 of Alsrue to include an additional detent positioned forwardly from the first detent 46 and even if it was possible to modify the power tool 10 of Alsrue so that the engagement between the rearward end of the first housing member 12 and the forward end of the second housing member 14 would not prevent the second

housing member 14 from being pivoted about the pivot 44 toward a pivoted position that would allow the pin 90 to engage the additional detent, the additional detent could not be positioned far enough forwardly along the periphery of the rear portion 40 of the first housing member 12 to allow the pin 90 to engage the additional detent and also allow the second housing member 14 to be pivoted about the pivot 44 toward a position in which the second housing member 14 is substantially perpendicular to the first housing member 12. Rather, even with these modifications to the power tool 10 of Alsrue, the second housing member 14 could only pivot toward a position in which the second housing member 14 is at an obtuse angle (i.e., a non-perpendicular angle) with respect to the first housing member 12.

Similarly, if the power tool 10 of Alsrue were modified to include an additional detent positioned forwardly from the second detent 48 (i.e., between the second detent 48 and a rearward end of the first housing member 12), the engagement between the rearward end of the first housing member 12 and the forward end of the second housing member 14 (see the lower portion of Figs. 2 and 5) would prevent the second housing member 14 from being pivoted about the pivot 44 toward a pivoted position which would allow the pin 90 to engage such an additional detent. To accommodate movement of the second housing member 14 toward such a position without causing interference between the rearward end of the first housing member 12 and the forward end of the second housing member 14, the cutout 72 would have to be enlarged by a significant amount. Alsrue does not teach or suggest that such a modification could or should be made to the cutout 72. Moreover, such an enlargement would necessitate the removal of the switch 28 and/or the redesign of the battery 26, and Alsrue makes no reference to how or why such modifications would or could be made and such a modification would not be obvious to a person of ordinary skill in the art of power tool design.

Therefore, Applicants respectfully submit that the Examiner has failed to present a *prima facie* case of obviousness of Claim 1 based upon the prior art as required by 35 U.S.C. § 103. Accordingly, independent Claim 1 is allowable. Dependent Claims 2-11 depend from Claim 1 and are allowable for the same and other reasons.

Claim 9 ultimately depends from independent Claim 1 and is allowable for at least the reasons discussed above with respect to Claim 1. As mentioned above, Alsrue does not teach or suggest the subject matter of Claim 1. Yang does not cure the deficiencies of Alsrue. Rather, as shown in Figs. 1 and 1-1 of Yang, the forward end of the handle 106 includes arcuately-shaped recesses for receiving the rearwardly extending arms of the body 103. The arcuately-shaped recesses limit pivoting movement of the handle 106 with respect to the body 103 and would prevent the handle 106 from being moved toward a position, in which the handle 106 is substantially perpendicular to the body 103.

For these and other reasons, Alsrue and Yang, alone or in combination do not teach or suggest all the claim limitations of Claim 9. Accordingly, Claim 9 is allowable.

Claim 11 ultimately depends from independent Claim 1 and is allowable for at least the reasons discussed above with respect to Claim 1. As mentioned above, Alsrue does not teach or suggest the subject matter of Claim 1. Kikuchi does not cure the deficiencies of Alsrue. Rather, as acknowledged by the Examiner, the power tool 10 of Kikuchi includes “a housing 14 having a body and a hand grip integrally formed with the body.” Moreover, the fact that the body and the hand grip of the power tool 10 of Kikuchi are *integrally formed* teaches away from the modification suggested by the Examiner. For these and other reasons, Alsrue and Kikuchi, alone or in combination do not teach or suggest all the claim limitations of Claim 11. Accordingly, Claim 11 is allowable.

B. Independent Claim 12 and dependent Claims 13-22

Alsrue does not teach or suggest a power tool including, among other things, a hand grip supported for movement relative to the body toward a position, in which the second grip surface is generally perpendicular to the first grip surface, as recited in independent Claim 12. Rather than re-present the arguments set forth above with respect to this contention, for brevity’s sake, Applicants refer to the discussion above for Claim 1. With respect to Claim 12, the same arguments apply to the lack of a suggestion to modify the power tool 10 of Alsrue as suggested by the Examiner or that such a modified power tool would or could include all of the claim limitations of independent Claim 12. Therefore, Applicants respectfully submit that the Examiner has failed to present a *prima facie* case of obviousness of Claim 12 based upon the prior art as required by 35 U.S.C. § 103. Accordingly, Claim 12 is allowable. Claims 13-22 depend from independent Claim 12 and are allowable for the same and other reasons.

Claim 20 ultimately depends from independent Claim 1 and is allowable for at least the reasons discussed above with respect to Claim 12. As mentioned above, Alsrue does not teach or suggest the subject matter of Claim 12. Yang does not cure the deficiencies of Alsrue. Rather than re-present the arguments set forth above with respect to this contention, for brevity’s sake, Applicants refer to the discussion above for Claim 9. With respect to Claim 20, the same arguments apply to the lack of a suggestion to modify the power tool 10 of Alsrue as suggested by the Examiner or that such a modified power tool would or could include all of the claim limitations of Claim 9. Therefore, Applicants respectfully submit that the Examiner has failed to present a *prima facie* case of obviousness of Claim 12 based upon the prior art as required by 35 U.S.C. § 103. For these and other reasons, Alsrue and Yang, alone or in combination do not teach or suggest all the claim limitations of Claim 20. Accordingly, Claim 20 is allowable.

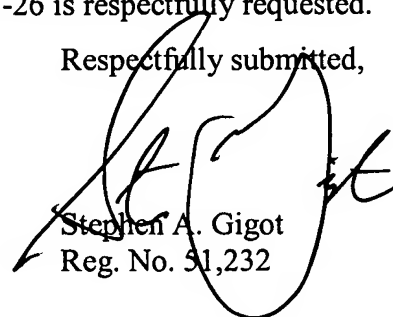
Claim 22 ultimately depends from independent Claim 12 and is allowable for at least the reasons discussed above with respect to Claim 12. As mentioned above, Alsrue does not teach or suggest the subject matter of Claim 12. Yang does not cure the deficiencies of Alsrue. Rather than re-present the arguments set forth above with respect to this contention, for brevity's sake, Applicants refer to the discussion above for Claim 11. With respect to Claim 22, the same arguments apply to the lack of a suggestion to modify the power tool 10 of Alsrue as suggested by the Examiner or that such a modified power tool would or could include all of the claim limitations of Claim 22. Therefore, Applicants respectfully submit that the Examiner has failed to present a *prima facie* case of obviousness of Claim 22 based upon the prior art as required by 35 U.S.C. § 103. For these and other reasons, Alsrue and Kikuchi, alone or in combination do not teach or suggest all the claim limitations of Claim 22. Accordingly, Claim 22 is allowable.

C. Independent Claim 23 and dependent Claims 24-26

Alsrue does not teach or suggest a method of operating a power tool including, among other things, the acts of moving the hand grip relative to the body to a third position in which the second grip surface is generally perpendicular to the first grip surface, and operating the power tool in the third position, as recited in Claim 23. Rather than re-present the arguments set forth above with respect to this contention, for brevity's sake, Applicants refer to the discussion above for Claim 1. With respect to Claim 23, the same arguments apply to the lack of a suggestion to modify the power tool 10 of Alsrue as suggested by the Examiner or that such a modified power tool would or could include all of the claim limitations of independent Claim 23. Therefore, Applicants respectfully submit that the Examiner has failed to present a *prima facie* case of obviousness of Claim 23 based upon the prior art as required by 35 U.S.C. § 103. Accordingly, Claim 23 is allowable. Claims 24-26 depend from independent Claim 23 and are allowable for the same and other reasons.

In view of the foregoing, allowance of Claims 1-26 is respectfully requested.

Respectfully submitted,



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